

REMARKS

Dealing with preliminary matters first, Applicant thanks the Examiner for considering the Information Disclosure Statement filed concurrently with the application. Further, Applicant thanks the Examiner for acknowledging Applicant's claim to priority and receipt of the priority document. Finally, it is noted with appreciation that the Examiner has accepted the drawings.

Claims 1-9 are all the claims pending in the application.

Claim Rejections Under 35 U.S.C. § 112

Claims 1-9 are rejected under 35 U.S.C. § 112 (second paragraph) as being indefinite. Claims 1 and 2 have been amended with the Examiner's comments in mind. Thus, it is submitted that this rejection has been overcome.

Claim Rejections Under 35 U.S.C. § 103

Claims 1-3 and 7-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tynan (U.S. Patent No. 4,028,302) in view of Plamthottam, et al. (U.S. Patent No. 4,906,421). Claims 4 and 5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tynan in view of Plamthottam, et al. as applied to claim 1 above and further in view of Burbank, et al. (Producing adhesives and sealants with twin-screw. *Adhesives & Sealants Industry*. June/July 1998., Vol. 5, Issue 5, p. 44). For the following reasons, Applicant respectfully traverse these rejections.

First of all, the process of the present invention relates to a process for preparing an adhesive formulation which comprises rubber, an hydrocarbon resin having adhesion imparting properties and a solvent. In particular, the process of the present invention allows the extruding

of an adhesive formulation which is dissolved in a solvent, thus solving the problem of rendering easy the successive spreading thereof on a support.

On the contrary, the main reference Tynan merely discloses a solution of acrylonitrile polymer in a solvent, which is markedly different from the adhesive formulations of the present invention. In this respect, it is submitted that acrylonitrile may be a component of a rubber (namely butadiene-styrene-acrylonitrile rubber), but is not a rubber *per se* and even the less in the context of Tynan, wherein it is used for the production of acrylic fibers (*See*, e.g. col. 1, line 11).

Hence, a fair evaluation of the content of Tynan would lead a person of ordinary skill in the art to conclude that it is not at all relevant to the technical sector of the present invention, concerning the production of rubber-based adhesive formulations.

The basic difference existing between the process of Tynan and the one of the present invention is rendered even more apparent by the fact that Tynan uses as solvent dimethylformamide or any other organic solvent boiling above 150 °C (see col. 2, lines 2326), whereas the boiling points of the solvents typically used in the process of the present invention - such as hexane, pentane and dichloropropane (see claim 8) - are much lower than 100 °C.

Hence, it should be plain that the skilled in the art of preparing adhesive formulations cannot derive in an obvious way any teaching from Tynan, which relates to a completely different class of products, so as any combination of the teachings of Tynan with Plamthottam, et al. would be possible only with hindsight and is, as such, a *priori inadmissible* in order to allege the obviousness of the present invention.

In any case, Plamthottam, et al. clearly teaches away from the process of the present invention. e.g. at col. 7, lines 58-60 of D2, it is indeed explicitly stated that "an essentially

solvent-free composition is then extruded from the extruder". The compositions which are extruded according to the process of Plamthottam, et al. and the present invention, respectively, are thus markedly different. As above indicated, the process of the present invention is indeed explicitly intended to extrude an adhesive formulation which is dissolved in a solvent, thus solving the problem of rendering easy the successive spreading thereof on a support. None of the cited prior art documents, Tynan and Plamthottam, et al., even hint at such a problem. Therefore, the fact that it is solved by the process of the present invention is clear evidence of the unobviousness of this latter.

Finally, Applicant emphasizes that also the further secondary reference cited - i.e. the article of Burbank et al. - provides (analogously to Plamthottam, et al.) teachings opposite to the ones of the present invention. On page 4 third paragraph from the bottom, and on page 5, IV and V paragraphs of Burbank et al., it is indeed emphasized the need of discharging low-end volatiles, i.e. any solvent possibly present in the composition processed in the extruder. Hence, also any argument based on Burbank et al. is a priori moot, because the gist of the present invention resides in extruding an adhesive composition purposively containing a volatile portion, namely a solvent.

Based on the foregoing, it is submitted that a person of ordinary skill in the art would not have combined the references in the manner proposed by the Examiner. Hence, the rejections are improper.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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